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No. 06-1434

IN THE

Supreme Court of the United States

MEDTRONIC SOFAMOR DANEK, INC., F/K/A SOFAMOR DANEK GROUP, INC., and MEDTRONIC SOFAMOR DANEK USA, INC.,

Petitioners,

v.

DEPUY SPINE, INC., F/K/A DEPUY ACROMED, INC., and BIEDERMANN MOTECH GMBH,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether the Federal Circuit correctly reversed a grant of summary judgment and remanded this case for additional factfinding after concluding—based on the particular patent and prosecution history involved in this case, and on the plaintiffs' theory of equivalence—that the plaintiffs had raised genuine issues of material fact regarding whether the accused Vertex® devices are insubstantially different from those claimed in the patent in suit.

PARTIES TO THE PROCEEDINGS AND CORPORATE DISCLOSURE STATEMENT

Johnson & Johnson owns more than 10% of the stock of respondent DePuy Spine, Inc.

Respondent Biedermann Motech GMBH is privately held.

Respondents otherwise agree with petitioners' statement of the parties to the proceedings.

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BRIEF IN OPPOSITION

Respondents DePuy Spine, Inc. and Biedermann Motech GMBH respectfully request that the Court deny the petition for a writ of certiorari for four basic and fundamental reasons:

First, the question presented by the petition is so vague and unlimited that it neither provides the proper notice to respondents, nor aids the Court in framing the dispute.

Second, the "foreseeability test" now being urged upon this Court by petitioners—even aside from its stark inconsistency with established Supreme Court precedent—was never urged on the district court, never argued to the Court of Appeals panel, and not set forth in the petition for rehearing and rehearing *en banc*. As a result, the parties never had an opportunity to make a record on this issue, never had an opportunity to present arguments and authorities on the issue, and no federal court has yet been given the opportunity to rule on it.

Third, because the Court of Appeals remanded the case for a trial with respect to petitioners' Vertex® device, the case presently stands in an interlocutory posture, and petitioners have shown no exceptional or compelling reason for this Court to depart from its ordinary practices and entertain this petition.

Fourth, the decision below, rendered by a unanimous panel, with rehearing *en banc* summarily denied, represents a factbound application of established law, on which there is no conflict in decisions—either within or without the Federal Circuit.

REASONS FOR DENYING THE WRIT

1. Petitioners' "Question Presented" fails this Court's Rule 14.1(a). That rule requires a question presented to be "expressed concisely in relation to the circumstances of the case," and not "argumentative or repetitive." As this Court has explained, this rule serves two essential purposes: *One*,

it "provides the respondent with notice of the grounds upon which the petitioner is seeking certiorari, and enables the respondent to sharpen the arguments as to why certiorari should not be granted"; and *two*, it "assists the Court in selecting the cases in which certiorari will be granted," by identifying the specific "particularly important questions" and thus "enabling [the Court] to make efficient use of [its] resources." *Yee v. City of Escondido*, 503 U.S. 519, 535-36 (1992).

The "Question Presented" here (Pet. i)—which contains, in reality, two components—is not expressed "in relation to the circumstances of [this] case." Rather, as petitioners themselves admit, it is phrased initially as the "broad and general" question of whether "the Federal Circuit [has] properly and consistently balanced the public-notice function of patent claims . . . with the desire to protect patentees from unscrupulous copyists . . . ?" And if not, the question continues, "how can the analysis of patent infringement under the doctrine of equivalents be better crafted to achieve more consistent and predictable outcome [*sic*]?"

Neither component serves Rule 14.1(a)'s purposes. Instead, the question is styled as such a "broad and general" (and argumentative) policy issue that it could sweep almost every conceivable question related to patent infringement within its scope. That is undoubtedly why the Question Presented concludes with the grandiose claim that "[t]he answer to this question can affect virtually every issued U.S. patent and every U.S. patent infringement action, as well as any enterprise and member of the public affected by the grant of a U.S. patent."

As presented, this question would not serve the purpose of limning the scope of the briefing and argument in the event of plenary review. That in turn would "thwart" the "integrity of the process of certiorari." *See Taylor v. Freeland & Kronz*, 503 U.S. 638, 646 (1992). The inappropriate

question presented by petitioners is a sufficient reason, in and of itself, to deny certiorari.

2. Although the Question Presented makes no mention of it, the petition goes on to urge this Court to adopt a "foreseeability test," ostensibly crafted from the Court's last doctrine-of-equivalents case, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). Pet. 23-27. Petitioners waived this argument by failing to make it below and that argument contradicts this Court's decisions.

a. For one, petitioners never made this argument below. They urged no "foreseeability test" on the district court, nor on the Court of Appeals. The panel hearing the case did not decide it by considering and rejecting a "foreseeability test," and petitioners' request for *en banc* rehearing did not seek the adoption or application of a "foreseeability test," either. "[O]rdinarily, this Court does not decide questions not raised or resolved in the lower court," *Youakim v. Miller*, 425 U.S. 231, 234 (1976) (per curiam), and nothing contained in the petition suggests that this case is so exceptional that the general rule should not prevail here. *See Lawn v. United States*, 355 U.S. 339, 362-63 n.16 (1958). Medtronic's waiver of such a "foreseeability test" should end that inquiry.

To allow petitioners to inject such an issue now would deprive this Court of the benefit of the lower courts' refinement and resolution. In *Austin v. United States*, 509 U.S. 602 (1993), for example, the petitioner asked this Court to "establish a multifactor test for determining whether a forfeiture is constitutionally 'excessive.'" *Id.* at 622. This Court properly "decline[d] that invitation," on the ground that "[p]rudence dictates that we allow the lower courts to consider that question in the first instance." *Id.* at 622-23 (citing *Yee*, 503 U.S. at 538).

Moreover, by failing to raise its "foreseeability test" until now, petitioners have deprived respondents of the opportunity to make an appropriate record in response to that asserted test. *See United States v. United Foods, Inc.*, 533

U.S. 405, 416-17 (2001) ("The Government's failure to raise its argument in the Court of Appeals deprived respondent of the ability to address significant matters that might have been difficult points for the Government."). If this case is indeed "[o]ne of [m]any" presenting this issue, as petitioners claim (Pet. 12), then the Court would be well advised to await a later vehicle, where the issue was not waived, and where the question is better framed.

b. For another, petitioners' "foreseeability test" would swallow headlong this Court's much narrower foreseeability inquiry from *Festo*. In that case, the Court ruled that an amendment to a patent claim limitation carries with it a rebuttable presumption that all equivalents were surrendered, unless the patentee could rebut the presumption by showing, *inter alia*, that the claimed equivalent was "unforeseeable at the time of the amendment." *Festo*, 535 U.S. at 738. Petitioners are not shy about admitting their goal here: to expand the foreseeability inquiry to *all* doctrine-of-equivalents cases, even those "when prosecution history estoppel is not implicated." Pet. 24.

To require equivalents to be foreseeable "in all cases" (Pet. 25) would completely obviate the careful, measured approach that this Court took in *Festo*, where the foreseeability approach was limited to claim limitations that had been amended during prosecution of the patent. What is more, such an approach would be contrary to every doctrine-of-equivalents case decided by this Court, including *Festo*, *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950), and going all the way back to *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853). None of these cases supports, let alone even suggests, petitioners' sweeping "foreseeability" rule. Indeed, in *Graver Tank*, the asserted equivalent (silicates of manganese) to the claim limitation (silicates of calcium or magnesium) was actually disclosed in the patent (*see id.* at 613 (Black, J., dissenting)), so the use of manganese there

was not just "foreseeable," but actually foreseen. Yet the finding of equivalence in *Graver Tank* was upheld. Petitioners make no effort to square their sweeping new rule with over 150 years of this Court's precedents.

Even if this Court were otherwise poised to embrace petitioners' new and radical suggestion, which it should not, it assuredly should not do so in a case where the issue was never raised, and neither the Federal Circuit nor the trial court developed a factual record or made considered legal rulings on the issue.

3. A third reason for denying the petition lies in the nonfinal posture of the case in view of the Court of Appeals' decision to remand for a trial on the equivalence of petitioners' Vertex® product. Ordinarily, this Court will not grant review when a case is in such an interlocutory posture: "[B]ecause the Court of Appeals remanded the case, it is not yet ripe for review by this Court." *Bhd. of Locomotive Firemen v. Bangor & Aroostock R.R.*, 389 U.S. 327, 328 (1967) (per curiam) (citing *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251, 257-58 (1916) ("The decree that was sought to be reviewed by certiorari at complainant's instance was not a final one, a fact that of itself alone furnished sufficient ground for the denial of the application . . . .")).

Petitioners are undoubtedly correct that there is no jurisdictional bar to review (Pet. 28), *see* 28 U.S.C. § 1254(1), but they do not offer any special or compelling reason for this Court to depart from the ordinary course and exercise review here.

4. Finally, the Court should decline to entertain the petition because the decision of the Court of Appeals was correct, and is not alleged to conflict with any decision of any other court of appeals, or of this Court. Rather, petitioners suggest only a generalized intra-circuit conflict in principle between cases they say evidence a "hard approach" and a "soft approach" to the doctrine of equivalents. Pet. 12-

21. Petitioners urge that this difference in approaches is exemplified by the different results in this case and in *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998).

Putting aside the fact that this Court rarely grants certiorari to resolve *intra*-circuit conflicts, which "are deemed an intramural matter to be resolved by the Court of Appeals itself," John M. Harlan, *Manning the Dikes*, 13 RECORD OF N.Y.C. BAR ASS'N 541, 552 (1958); *Davis v. United States*, 417 U.S. 333, 340 (1974), the differences in results in these cases were not a product of the application of different or conflicting legal rules, or, for that matter, jurisprudence of different "hardnesses" or "softnesses." Rather, the different results are simply a product of the differing facts and appellate records in those cases. Pet. App. 19a n.1. This demonstrates that the issue here is so factbound that certiorari would be both inappropriate and ineffective. *See, e.g., United States v. Johnston*, 268 U.S. 220, 227 (1925) ("We do not grant a certiorari to review evidence and discuss specific facts.").

In *Warner-Jenkinson*, this Court anticipated that vitiation rulings would be heavily fact-dependent: "Thus, under the particular facts of a case, . . . if a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court . . . ." 520 U.S. at 39 n.8. *See also Graver Tank*, 339 U.S. at 609 ("[E]quivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case."). Thus, "the particular facts of a case" make all the difference in cases of alleged vitiation, not supposed "hard" or "soft" jurisprudential approaches.

Indeed, the Court of Appeals recognized the factbound nature of the "vitiation" inquiry in its opinion here, noting that vitiation has been found when, "on the facts or theories presented in a case, a limitation would be read completely out of the claim." Pet. App. 16a. That is why the Court of Appeals found its prior decision in *Tronzo* "factually

distinguishable." Pet. App. 19a. There, the patent contained independent claims drawn to artificial hip sockets having a "socket with no specific shape," and those claims were held invalid because of the absence of an adequate disclosure in the written description under 35 U.S.C. § 112, ¶ 1. Pet. App. 20a (citing *Tronzo*, 156 F.3d at 1158-60). Tronzo's efforts to then expand its other, not-invalidated claims for a prosthesis having "a generally conical outer surface," based on expert testimony that "*any* shape would be equivalent," were properly rejected by the Federal Circuit. Pet. App. 20a (citing *Tronzo*, 156 F.3d at 1160).

In this case, by contrast, there were no invalidated claims lacking an adequate description, and respondents' equivalence case did not attempt to recapture the territory of those invalidated claims by "propos[ing] that any shape would meet the 'spherically-shaped' limitation." In fact, respondents' expert presented a "particularized declaration" demonstrating his theory of equivalence using the function-way-result test (which this Court endorsed in *Warner-Jenkinson*, 520 U.S. at 39-40). He did not declare or even suggest that any shape would meet that test. *See* Pet. App. 20a-21a; C.A. App. 10367, 10539-40. (Petitioners are therefore incorrect to claim, as they do, that Respondents' expert in this case "testified that the specifically claimed shape was irrelevant." Pet. 15.) Also, as the Court of Appeals noted, "unlike the patent at issue in *Tronzo*, the written description and the '678 patent does not label other shapes as 'prior art' and 'inferior.'" Pet. App. 21a. In short, respondents' equivalence theory, unlike the theory advanced and rejected in *Tronzo*, was closely tethered to the claim language, in a way that did not "vitiate" any limitation in the patent. That makes this case not "strikingly similar" to *Tronzo* (Pet. 16), but strikingly different.

It is curious that, for all of petitioners' dependence on the alleged intra-circuit conflict in principle with the *Tronzo* decision, they fail to even cite two other cases, decided between *Tronzo* and this case, that further confirm how

understandable the different results in these cases are, based on the fact-and-context-dependent vitiation inquiry. In *Optical Disk Corp. v. Del Mar Avionics*, 208 F.3d 1324, 1337 (Fed. Cir. 2000), the Court of Appeals held that "*Tronzo* does not stand for the proposition that a claim limitation describing a specific shape of a claimed structure cannot be infringed under the doctrine of equivalents by a differently shaped structure." And *Freedman Seating Co. v. American Seating Co.*, 420 F.3d 1350, 1361 (Fed. Cir. 2005) confirmed that what "particularly troubled" the *Tronzo* court was expert testimony that suggested that "'*any* shape would be equivalent to the conical limitation.'" An even more recent decision of the Court of Appeals further confirms, consistent with this Court's pronouncement in *Warner-Jenkinson*, that the vitiation inquiry is dependent on the "particular circumstances" of the claim language and the equivalence theory asserted in each case. *Foremost in Packaging Sys., Inc. v. Cold Chain Techs., Inc.*, No. 2006-1582, slip op. at 4 (Fed. Cir. May 2, 2007) (citing the decision below in this case).

The asserted differences between other Federal Circuit decisions, said by petitioners to evidence either a "'hard' approach to the doctrine of equivalents" (Pet. 17) or a "'soft' mode" (Pet. 19), are similarly understandable in this fashion. They, too, are fact- and context-dependent applications of the doctrine of equivalents, a doctrine which, "[i]t is true . . . renders the scope of patents less certain." *Festo*, 535 U.S. at 732. But that is a necessary part of the bargain, as this Court has observed, because "[i]f patents were always interpreted by their literal terms, their value would be greatly diminished." *Id.* at 731.

Petitioners' argument, stripped to its essence, is that courts should "adhere to the specific wording of a claim." Pet. 17; *see also* Pet. 23 (urging that the Court of Appeals here should have adhered to "the literal wording of the claim"). But that would effectively eliminate the doctrine of equivalents, contrary to this Court's pronouncement that

"[t]he scope of a patent is not limited to its literal terms." *Festo*, 535 U.S. at 732 (citing *Winans*, 56 U.S. (15 How.) at 347). Indeed, petitioners' complaint about the decision below and other allegedly "soft" approaches to the doctrine of equivalents would also seem to apply to a number of this Court's decisions applying the doctrine of equivalents to patent claims literally requiring a device to have a specified geometric shape. Most notable among these is *Winans* itself, which held that a claim requiring "a frustum of a cone" was infringed by non-conical structures (octagons and pyramids). 56 U.S. (15 How.) at 339-40. *See also Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 40-41 (1929) (upholding equivalence "[d]espite the changes in the" accused product from "the structure . . . disclosed" by the patent); *Union Paper-Bag Mach. Co. v. Murphy*, 97 U.S. 120, 123-24 (1877) (upholding equivalence between the patent's "cutter arranged to ascend and descend," and the accused serrated knife that "neither rises nor falls," yet cut paper that was moved over it); *Ives v. Hamilton*, 92 U.S. 426, 430-31 (1875) (upholding equivalence between a patent claim including a saw with curved guides and an accused "saw in which the guides are not curved"). Thus, the Court of Appeals' decision here—even if it could be categorized as being in a so-called "'soft' mode"—would still be in full accord with this Court's own precedents.

* * * *

In light of the factbound nature of this case, the poor question presented, the fact that petitioners' proposed "foreseeability test" has been newly minted for this late stage of litigation, the non-final posture of this case, the absence of any conflict (even an intra-circuit one), and the correctness of the decision below, the petition presents no colorable basis for review.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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